

# PATENT COOPERATION TREATY

From the **TOWNSEND & TOWNSEND**  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY & CREW

To: **MARK D. BARRISH**  
**TOWNSEND AND TOWNSEND AND CREW LLP**  
**TWO EMBARCADERO CENTER, 8TH FLOOR**  
**SAN FRANCISCO, CALIFORNIA 94111-3834**

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**PCT**

RECEIVED WRITTEN OPINION

(PCT Rule 66)

Applicant's or agent's file reference <b>16355-24PC</b>		Date of Mailing (day/month/year) <div style="text-align: center; font-weight: bold; font-size: 1.2em;">20 JUN 1997</div>
International application No. <b>PCT/US96/07483</b>		International filing date (day/month/year) <b>21 MAY 1996</b>
International Patent Classification (IPC) or both national classification and IPC <b>IPC(6): A61F 6/06; and US Cl.: 128/831</b>		Priority date (day/month/year) <b>07 JUNE 1995</b>
Applicant <b>CONCEPTUS, INC.</b>		

*20 Aug. 1997*  
DOCKETED BY *jal*

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.

2. This opinion contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step or industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

3. The applicant is hereby invited to reply to this opinion.

**When?** See the time limit indicated above. ~~The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).~~

**How?** By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

**Also** For an additional opportunity to submit amendments, see Rule 66.4.  
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.  
For an informal communication with the examiner, see Rule 66.6.

**If no reply is filed,** the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 07 OCTOBER 1997

Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231	Authorized officer <i>For</i> <b>MICHAEL A. BROWN</b>
Facsimile No. (703) 305-3230	Telephone No. (703) 308-2682

## PCT/US96/07483

1. This opinion has been drawn on the basis of (*Substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

2. The amendments have resulted in the cancellation of:

3. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box. Additional observations below (Rule 70.2(c)).

Form PCT/IPEA/408 (Box I) (January 1994)\*

WRITTEN OPINION

International application No.

PCT/US96/07483

**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. STATEMENT**

Novelty (N)	Claims	(Please See supplemental sheet)	YES
	Claims	(Please See supplemental sheet)	NO
Inventive Step (IS)	Claims	(Please See supplemental sheet)	YES
	Claims	(Please See supplemental sheet)	NO
Industrial Applicability (IA)	Claims	(Please See supplemental sheet)	YES
	Claims	(Please See supplemental sheet)	NO

**2. CITATIONS AND EXPLANATIONS**

Claims 1, 2, 7-9 and 12 lack novelty under PCT Article 33(2) as being anticipated by EMMETT.

Claims 3, 5, 6, 10 and 11 lack an inventive step under PCT Article 33(3) as being obvious over EMMETT in view of RUDOLPH. It would have been obvious to one having ordinary skill in the art at the time of the invention that the primary coil could be made of stainless steel because it is a material that is durable, but not harmful to the body.

Claims 4, 13, 16 and 17 meet the criteria of PCT Article (2)-(4) because the prior art does not disclose or suggest a contraceptive device having an alloy including beryllium copper.

Claims 14, 15 and 18-23 lack an inventive step under PCT Article 33(3) as being obvious over GUGLIELMI in view of EMMETT. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the coil as disclosed by GUGLIELMI could be constructed of copper as taught by EMMETT because copper will enhance the contraceptive action of the device, while at the same time reduce any bleeding from inserting the device. The coil diameter, length and width recited in the claims are inherent in the prior art.

Claims 24 and 25 lack novelty under PCT Article 33(2) as being anticipated by EMMETT.

Claims 26-30 lack an inventive step under PCT Article 33(3) as being obvious over ERB in view of EMMETT. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the copper material as taught by EMMETT could be substituted for the material as disclosed by ERB, because copper is a material that will not cause harm to the body while providing a means of contraceptive.

Claim 31 lacks an inventive step under PCT Article 33(3) as being obvious over ERB in view of EMMETT as applied to claim 26 above, and further in view of LESSEN. It would have been obvious to one (Continued on Supplemental Sheet.)

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**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

**TIME LIMIT:**

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.

**V. 1. REASONED STATEMENTS:**

The opinion as to Novelty was positive (YES) with respect to claims 3-6, 10, 11, 13, 15, 16, 18-25, 30.

The opinion as to Novelty was negative (NO) with respect to claims 1, 2, 7-9, 12, 14, 17, 26-29.

The opinion as to Inventive Step was positive (YES) with respect to claims NONE.

The opinion as to Inventive Step was negative (NO) with respect to claims 1-3, 5-12, 14, 15, 18-30.

The opinion as to Industrial Applicability was positive (YES) with respect to claims 1-31.

The opinion as to Industrial Applicability was negative (NO) with respect to claims NONE.

**V. 2. REASONED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):**

having ordinary skill in the art at the time of the invention that the method of applying an electrical current through the body and into a fallopian tube as taught by LESSEN could be incorporated into the method steps as disclosed by ERB, and taught by EMMETT in order to provide permanent sterilization to a patient.

----- NEW CITATIONS -----

US 5,354,295 A (GUGLIELMI et al.) 11 OCTOBER 1994, see the entire document.

US 3,858,571 A (RUDOLPH) 07 JANUARY 1975, see the entire document.